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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,523	04/17/2001	Yong-Qian Wu	23754X	5679

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GUILFORD PHARMACEUTICALS C/O
FOLEY & LARDNER
3000 K STREET, NW
WASHINGTON, DC 20007-5143

EXAMINER

TRUONG, TANTHOM NGO

ART UNIT	PAPER NUMBER
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1624

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DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,523

Applicant(s)

WU ET AL.

Examiner

Tamthom N. Truong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40, and 48-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-40 and 48-51 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Applicant's amendment of 8-27-03 is acknowledged. Because of the divergent subject matter, the following restriction is presented.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

1. Claims 1-4, 7-10, and 48 (part of each), drawn to compounds of formula I with the following substituents:

R_1 is not a ring, and $n = 1-3$;

Also, their pharmaceutical composition, and method for affecting neuronal activity;

classified in class 514, 540, 544, 548, various subclasses depending on substituents.

2. Claims 1-4, 7-10, and 48 (part of each), drawn to compounds of formula I with the following substituents:

R_1 is a ring, and $n = 1$;

Also, their pharmaceutical composition, and method for affecting neuronal activity;

classified in classes 514, 548, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

3. Claims 1, 2, 4, 7-10, and 48 (part of each), drawn to compounds of formula I with the following substituents:

R_1 is a ring, and $n = 2$;

Also, their pharmaceutical composition, and method for affecting neuronal activity;

classified in classes 514, 544, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

4. Claims 1, 2, 4, 7-10, and 48 (part of each), drawn to compounds of formula I with the following substituents:

R_1 is a ring, and $n = 3$;

Also, their pharmaceutical composition, and method for affecting neuronal activity;

classified in classes 514, 540, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

5. Claims 5, 6, drawn to a pharmaceutical composition comprising a compound of formula I and an additional neurotrophic factor, classified in class 514, various subclasses depending on substituents. Further restriction will be required if this group is elected.

6. Claims 11, 12, 14, 17-20, and 49 (part of each), drawn to compounds of formula II with the following substituents:

R_1 is not a ring, and $n = 1-3$;

Also, their pharmaceutical composition, and method for affecting neuronal activity;

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classified in class 514, 540, 544, 548, various subclasses depending on substituents.

7. Claims 11-14, 17-20, and 49 (part of each), drawn to compounds of formula II with the following substituents:

R_1 is a ring, and $n = 1$;

Also, their pharmaceutical composition, and method for affecting neuronal activity;

classified in class 514, 548, various subclasses depending on substituents. Further restriction will be required if this group is elected.

8. Claims 11-14, 17-20, and 49 (part of each), drawn to compounds of formula II with the following substituents:

R_1 is a ring, and $n = 2$;

Also, their pharmaceutical composition, and method for affecting neuronal activity;

classified in class 514, 544, various subclasses depending on substituents. Further restriction will be required if this group is elected.

9. Claims 11, 12, 14, 17-20, and 49 (part of each), drawn to compounds of formula II with the following substituents:

R_1 is a ring, and $n = 3$;

Also, their pharmaceutical composition, and method for affecting neuronal activity;

classified in class 514, 540, various subclasses depending on substituents. Further restriction will be required if this group is elected.

10. Claims 15, 16, drawn to a pharmaceutical composition comprising a compound of formula II and an additional neurotrophic factor, classified in class 514, various subclasses depending on substituents. Further restriction will be required if this group is elected.
11. Claims 21-24, 27-30, and 50 (part of each), drawn to compounds of formula III with the following substituents:

R_1 is not a ring, and $n = 1-3$;

Also, their pharmaceutical composition, and method for affecting neuronal activity;

classified in class 514, 540, 544, 548, various subclasses depending on substituents.

12. Claims 21, 22, 24, 27-30, and 50 (part of each), drawn to compounds of formula III with the following substituents:

R_1 is a ring, and $n = 1$;

Also, their pharmaceutical composition, and method for affecting neuronal activity;

classified in class 514, 548, various subclasses depending on substituents. Further restriction will be required if this group is elected.

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13. Claims 21, 22, 24, 27-30, and 50 (part of each), drawn to compounds of formula III with the following substituents:

R_1 is a ring, and $n = 2$;

Also, their pharmaceutical composition, and method for affecting neuronal activity;

classified in class 514, 544, various subclasses depending on substituents. Further restriction will be required if this group is elected.

14. Claims 21, 22, 24, 27-30, and 50 (part of each), drawn to compounds of formula III with the following substituents:

R_1 is a ring, and $n = 3$;

Also, their pharmaceutical composition, and method for affecting neuronal activity;

classified in class 514, 540, various subclasses depending on substituents. Further restriction will be required if this group is elected.

15. Claims 25, 26, drawn to a pharmaceutical composition comprising a compound of formula III and an additional neurotrophic factor, classified in class 514, various subclasses depending on substituents. Further restriction will be required if this group is elected.

16. Claims 31-34, 37-40, and 51 (part of each), drawn to compounds of formula IV with the following substituents:

R_1 is not a ring, and $n = 1-3$;

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Also, their pharmaceutical composition, and method for affecting neuronal activity;

classified in class 514, 540, 544, 548, various subclasses depending on substituents.

17. Claims 31, 32, 34, 37-40, and 51 (part of each), drawn to compounds of formula IV with the following substituents:

R_1 is a ring, and $n = 1$;

Also, their pharmaceutical composition, and method for affecting neuronal activity;

classified in class 514, 548, various subclasses depending on substituents. Further restriction will be required if this group is elected.

18. Claims 31, 32, 34, 37-40, and 51 (part of each), drawn to compounds of formula IV with the following substituents:

R_1 is a ring, and $n = 2$;

Also, their pharmaceutical composition, and method for affecting neuronal activity;

classified in class 514, 544, various subclasses depending on substituents. Further restriction will be required if this group is elected.

19. Claims 31, 32, 34, 37-40, and 51 (part of each), drawn to compounds of formula IV with the following substituents:

R_1 is a ring, and $n = 3$;

Also, their pharmaceutical composition, and method for affecting neuronal activity;

classified in class 514, 540, various subclasses depending on substituents. Further restriction will be required if this group is elected.

20. Claims 35, 36, drawn to a pharmaceutical composition comprising a compound of formula IV and an additional neurotrophic factor, classified in class 514, various subclasses depending on substituents. Further restriction will be required if this group is elected.

Inventions of Groups 1 to 20 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different formulae and combination of ring systems.

- a. The inventions of groups 1-5 are drawn to the subject matter related to formula I. Those of groups 6-10 are drawn to the subject matter related to formula II. Those of groups 11-15 are drawn to the subject matter related to formula III. Those of groups 16-20 are drawn to the subject matter related to formula IV.
- b. Within each formula, the core can vary from 5-, 6-, to 7-membered ring depending on the value of "n". In addition, variable R_1 represents several functional groups and ring moieties. Thus, as R_1 and "n" vary, each formula represents a different set of compounds that is patentably distinct over each other, and requires a separate

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search since a reference anticipated one group, would not do so on the other groups.

Therefore, a burden of searching exists.

c. Furthermore, the inventions of groups 5, 10, 15, 20 comprise an additional neurotrophic factor which requires an additional search. Again, this poses a burden of searching.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Sean Passino on 11-14-03 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (7 am -12 pm, and 3 pm - 6 pm) starting from 10-1st -03.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



T. Truong

November 14, 2003



ALAN L. ROTMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600